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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,813	12/29/2003	William Dubrul	GTEC 1001-4	1880

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HAYNES BEFFEL & WOLFELD LLP  
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HALF MOON BAY, CA 94019

EXAMINER
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BACHMAN, LINDSEY MICHELE

ART UNIT	PAPER NUMBER
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3734

NOTIFICATION DATE	DELIVERY MODE
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07/09/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

<b>Office Action Summary</b>	<b>Application No.</b> 10/747,813	<b>Applicant(s)</b> DUBRUL ET AL.	
	<b>Examiner</b> LINDSEY BACHMAN	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-24 and 75-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-24 and 75-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4-8-08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 April 2008 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 8 April 2008 have been fully considered but they are not persuasive.

Regarding the rejection under 35 U.S.C. 102(a) under Tsugita'544, Applicant argues that the membrane (514) of Tsugita does not have any effect on the permeability of the vessel occluding element (513). The claimed phrase "a membrane contacting the braided element so that the braided element is substantially impermeable when in the radially expanded state." is being treated as a product by process limitation, and because there is a membrane contacting the braided element and the braided element is substantially impermeable, the limitations of the claim are met by Tsugita'544. As set forth in MPEP 2113, product by process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. Once a product appearing to be

substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference.

Regarding Applicant's arguments that Tsugita'544 does not disclose a braided member, this is not convincing because the combination of 513 and 551 are considered braided because they are shown overlapping to form a weave in Figure 31. However, even if this is not convincing, the claim is rejected in the alternative under 35 U.S.C. 103(a) as being obvious over Evans, as discussed in the rejection below.

Regarding newly added claims 78-81, the expandable elements (90, 91) taught by Barbut read on the claim limitations because in their expanded state they partially occlude the vessel.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 22 and 75 are rejected under 35 U.S.C. 102(a) as being anticipated by Tsugita et al. (US Patent 6,231,544) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsugita'544 in view of Evans et al. (US Patent 5,540,658).**

Claim 22 and 75: Tsugita teaches a device that contains a catheter (50) having a proximal and distal end; an expandable and contractible vessel-occluding element (513 shown in Figure 31) positioned near the distal end of the catheter (regarding "expandable and contractible", Tsugita discloses the use of a self-expanding foam in the balloon 514 in column 30, lines 19-29 and later teaches that the self-expanding foam can be used to expand and contract the balloon and therefore the device in combination with a vacuum attaching in column 30, lines 49-61). The vessel-occluding element contains a braided element (combination of 513 and 551 are considered braided because they are shown overlapping to form a weave in Figure 31) and a membrane (514) that is in contact with the braided element. The braided element is impermeable when in the expanded state (column 30, lines 19-29). The vessel-occluding element is

funnel shaped (see Figure 31) and has an opening for receiving material (see Figure 31).

If it is not convincing that the combination of elements 513 and 551 of Tsugita'544 are braided, it would have been obvious to use a braided element because it is old and well known to do so, as shown for example by Evans'658, who teaches that it is known to cover a braided mesh (28) with an impermeable membrane (column 6, lines 47-67). Further, Evans'658 teaches that the membrane can be programmed to expand and contract with the mesh in a predictable way. The claim would have been obvious because a particular known technique was recognize as part of the ordinary capabilities of one skilled in the art.

**Claims 23, 24, 76 and 77-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsugita'544, as applied to Claims 22 and 75, in view of Barbut et al. (US Patent 5,662,671).**

Tsugita'544 teaches the limitations of Claims 23, 24, 76 and 77 except for a second expandable and contractible element that is extendable from the distal end.

Barbut'671 discloses a second expandable and contractible element (90, 91) positionable and extendable from the catheter distal end (see Figure 21 and column 18, lines 62 to column 19, line 12) because they help center the catheter device in the vessel. The second expandable and contractible element is a balloon (column 18, lines 53-57) that partially occludes the blood vessel when in the expanded state. It would have been obvious to one of ordinary skill in the art at the time the invention was made

to modify the device taught by Tsugita'544 with the expandable balloon in order to help center the device in the vessel.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSEY BACHMAN whose telephone number is (571)272-6208. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. B./  
Examiner, Art Unit 3734

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Art Unit: 3700

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/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773